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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARCO SCIBORA

Appeal 2008-6303
Application 09/266,183
Technology Center 2600

Decided: January 5, 2009

Before KENNETH W. HAIRSTON, ROBERT E. NAPPI
and JOHN A. JEFFERY, *Administrative Patent Judges*.
HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1 to 21. Based upon a withdrawal of the appeal to the Board of claims 1 to 16 (Reply Br. 2), the Examiner canceled claims 1 to 16. Accordingly, claims 17 to 21 remain before us on appeal. We have jurisdiction under 35 U.S.C. § 6(b).

We will sustain the obviousness rejections.

Appellant has invented an apparatus for a customer to record a custom compact disc at a retail premises. At a preview station in the retail premises, a customer selects desired music tracks from original compact discs stored digitally in a music memory. The selected tracks are recorded on a compact disc by a compact disc cutter. A main memory is connected to the music memory, the preview station, and the disc cutter. At the retail premises, the customer can use a scannable purchase card having a unique bar code keyed to the music selections chosen by the customer (Figs. 3 and 4; Spec. 9 to 12).

Claims 1 and 17 are illustrative of the claims on appeal, and they read as follows:

1. An apparatus for recording a custom compact disc at a retail premises, whereby the customer selects the desired music tracks on the compact disc from original compact discs stored digitally, comprising:
 - (a) a music memory containing a plurality of digitally-stored music selections;
 - (b) a plurality of preview stations distributed throughout the retail premises;
 - (c) a plurality of compact disc cutters; and
 - (d) a main computer connected to the memory, to the preview stations, and to the compact disc cutters.
17. The apparatus of claim 1, further comprising a plurality of scannable purchase cards each having a unique bar code keyed to the music selections chosen by the customer.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Kaplan	US 5,237,157	Aug. 17, 1993
Alexander	US 5,633,839	May 27, 1997
Tsevdos	US 5,734,719	Mar. 31, 1998
Cook	US 5,860,068	Jan. 12, 1999

The Examiner rejected claim 17 under 35 U.S.C. § 103(a) based upon the teachings of Tsevdos, Alexander, and Cook.

The Examiner rejected claims 18 to 21 under 35 U.S.C. § 103(a) based upon the teachings of Tsevdos, Alexander, Cook, and Kaplan.

ISSUE

Appellant contends that “no disclosure . . . of a purchase card having a unique bar code keyed to the music selections chosen by the customer” can be found in the applied references (App. Br. 6 and 7). Thus, the issue before us is has the Appellant shown error in the Examiner’s finding that the applied references teach or would have suggested to the skilled artisan a purchase card having a unique bar code keyed to the music selections chosen by a customer?

FINDINGS OF FACT

1. As seen in Figures 3 and 4 of Appellant’s drawing, the claimed scannable purchase card 130 is used at a preview station 114 at a retail premises to make a purchase of musical tracks selected from a digitally stored compact disc.

2. Appellant's disclosure states that the purchase cards 130 "may be Smartcards which also include a memory for storing information such as the authorized amount of music which the customer is allowed to purchase with the purchase card 130" (Spec. 10).

3. "The purchase card 130 will be encoded with a unique barcode (or a magnetic strip with store name, billing information, etc.)" (Spec. 10).

4. According to Appellant (Spec. 11), "[s]canning a unique barcode on the purchase card 130 allows the apparatus to keep track of all song selections and their originator/owner at any station."

5. By linking or keying each selected song/musical track to the unique barcode on the purchase card 130, it is possible to organize all selected tracks and record a custom CD for the holder of the purchase card 130 (Spec. 11 and 12).

6. Figure 13 of Tsevdos shows a retail premises where a customer can use a preview station 1303 to select desired musical tracks from an original compact disc digitally stored in memory (Figs. 13 and 14; col. 2, l. 63 to col. 3, l. 3; col. 17, l. 1 to col. 18, l. 14). A main memory controls the preview station, the music memory and the compact disc cutter (col. 4, ll. 39 to 43).

7. In Tsevdos, a customer inserts a membership/purchase card into a card reader 1604 where it is scanned so that the customer can select and purchase digitally stored musical tracks (Figs. 13 and 16; col. 17, ll. 6 to 18; col. 36, ll. 58 to 62).

8. The musical tracks selected by the customer are linked/keyed to the information scanned from the membership/purchase card. According to Tsevdos, the linked/keyed information includes the artist of the musical

selection, title of the musical selection, the number of copies, and the media type (i.e., compact disc or cassette tape) (col. 17, ll. 26 to 36).

9. At the point of sale (POS) terminal 1308 in Tsevdos, the membership/purchase card is scanned again, and the linked/keyed musical selections are retrieved from memory so that the disc cutter can record them on a compact disc for the customer (col. 17, l. 37 to col. 18, l. 14).

10. Cook describes the use of a machine readable gift certificate/token at a retail premises to make a purchase (col. 5, ll. 21 to 34).

PRINCIPLES OF LAW

The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If that burden is met, then the burden shifts to the Appellant to overcome the prima facie case with argument and/or evidence. *See Id.*

The Examiner's articulated reasoning in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

One can not show nonobviousness by attacking references individually where the rejection is based on a combination of references. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

ANALYSIS

In Tsevdos, the purchase of a compact disc with selected musical tracks is performed in the same manner as set forth in Appellant's disclosed and claimed invention (Finding of Facts 1 to 9). Although Tsevdos is silent

as to what type of encoding is used on the membership/purchase card (*see* Finding of Fact 7), we find that it is most likely one of the two most common types (i.e., barcode or a magnetic strip). We reach this conclusion based on encoding standards for scannable cards and Smartcards, and Appellant's own disclosure concerning encoded purchase cards (Finding of Fact 3). Thus, it would have been manifestly obvious to one of ordinary skill in the art to provide barcode encoding on the membership/purchase card used in Tsevdos as set forth in claims 17 to 21 on appeal.

With respect to the teachings of Cook (Finding of Fact 10), the machine readable gift certificate/token described therein for use at a retail premises operates in the same manner as the membership/purchase card in Tsevdos.

Appellant has presented the same patentability argument (i.e., the lack of a teaching of a purchase card having a unique bar code keyed to the musical selections chosen by the customer in the applied references) for claims 17 to 20. As indicated *supra*, we have reached an opposite conclusion based on the teachings of Tsevdos alone or in combination with the teachings of Cook.

Appellant's additional argument for claim 19 is that "Cook does not disclose steps (a), (h), (j), (k), (l) or (q)" (App. Br. 6). Appellant's argument concerning the shortcomings in the teachings of Cook are not convincing of the nonobviousness of the claimed invention set forth in claim 19 because one can not show nonobviousness by attacking references individually when the rejection is based on a combination of references. *Keller*, 642 F.2d at 425.

With respect to Appellant's argument concerning claim 21 (App. Br. 7), we find that the skilled artisan would have known based upon the teachings of Tsevdos and common sense to either purchase the membership/purchase card upon entering the retail premises or after a decision is made to make a musical purchase.

In summary, Appellant's arguments throughout the briefs do not convince us of any error in the Examiner's positions in the rejections. *See Oetiker*, 977 F.2d at 1445. The Examiner's rationale for combining the teachings of the references involves nothing more than common knowledge and common sense in the art. *See Kahn*, 441 F.3d at 988.

CONCLUSION OF LAW

Appellant has not shown that the Examiner erred in rejecting claims 17 to 21 under § 103.

ORDER

The obviousness rejections of claims 17 to 21 are affirmed because the Appellant did not establish any error in the Examiner's rejections.

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Application 09/266,183

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

KIS

SCHWABE, WILLIAMSON & WYATT, P.C.
1420 FIFTH, SUITE 3010
SEATTLE, WA 98101